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D-1112 R4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Enright, et al.)	
)	
Application No.: 09/991,748)	Art Unit 3696
)	
Confirmation No.: 7030)	
)	
Filed: November 23, 2001)	Patent Examiner
)	Frantzy Poinvil
)	
Title: Automated Banking Machine)	
System and Method)	

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING OF BOARD DECISION

Sir:

Pursuant to 37 C.F.R. § 41.52, the Appellants hereby request rehearing of the Decision dated September 22, 2009 ("Decision") by the Board of Patent Appeals and Interferences (hereinafter "Board") in Appeal No. 2008-004397.

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**Points Believed to Have Been
Misapprehended or Overlooked by the Board**

The Board's reasons for sustaining the anticipation rejections of claims 1, 6-15, 17-19, 21-27, 29-30, 33, and 35-39 can be found in the Decision.

I. Recent Relevant Decision By The Federal Circuit

The Decision is not in compliance with the Federal Circuit's recent decision *In re Skvorecz*, (Fed. Cir. 9/3/2009; Appeal No. 2008-1221). "The protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation (*Skvorecz*, at 8). "The signal 'comprising' does not render a claim anticipated by a device that contains less (rather than more) than what is claimed" (*Skvorecz*, at 8). "Anticipation cannot be found, as a matter of law, if any claimed element or limitation is not present in the reference" (*Skvorecz*, at 9).

The Appellants respectfully submit that the Board gave claims a legally incorrect interpretation; misconstrued the transition language signal "comprising"; and did not properly find anticipation as a matter of law.

II. The Burden Of Proof Was Misapprehended By The Board

The Appellants respectfully submit that the Board improperly required Appellants to prove the anticipation rejections were incorrect. Appellants do not have a legal burden to prove patentability. 35 U.S.C. § 102 dictates that "A person shall be entitled to a patent *unless*" one of the conditions for denying a patent is established. It is the duty of the Board to "review adverse decisions of *examiners* upon applications for patents" (35 USC § 6(b)). It was the Examiner's burden to establish a *prima facie* case of anticipation. *In re Piasecki*, 745 F.2d 1468, 1472, 223

USPQ 785, 788 (Fed. Cir. 1984). There is no legal basis for shifting the burden of proof from the Examiner onto Appellants in violation of the patent statutes.

The record reflects that the Board only based its Decision on whether the *Appellants'* arguments proved error in the Examiner's rejections. Evidence that the Board placed the burden of proof on Appellants can be found throughout the Decision (e.g., page 3, lines 8-11). The Board improperly based their Decision only on a review of the Appellants' arguments rather than on a review of the Examiner's positions with regard to the issues of patentability. Under the Board's approach the review improperly "took on a life of its own" (*In re Piasecki*, supra) in evaluating whether Appellants had shown that the Examiner erred in rejecting claims, rather than (properly) evaluating the facts on which the Examiner's allegation of anticipation was based. That is, under the Board's approach the Appellants were on trial. Also, the Board does not explain how any Appellant can prove a negative with regard to an anticipation rejection, i.e., prove what a reference does *not* teach.

The Board misapprehended its authority in requiring Appellants to prove non anticipation rather than evaluating whether the Examiner had met the burden of establishing a *prima facie* case of anticipation. Appellants respectfully submit that because the burden of proof was misapprehended by the Board, the Decision is in error.

III. The Decision Is Based On Critical Factual Errors

Appellants respectfully submit that the Board used an improper legal standard in determining anticipation. Appellants respectfully submit that the Board's basis for sustaining the anticipation rejections also contains critical errors of fact. The Decision is based on these errors. As a result, the Decision is erroneous.

Error #1

The Board erred in imputing an incorrect definition to the term "electronic signature" (i.e., finding of fact 3). As the Decision is based on an incorrect interpretation, it is erroneous.

1). The present application was filed November 23, 2001, and claims benefit of provisional application 60/253,221 filed November 27, 2000. Like the present application, the provisional application also discusses exemplary embodiments with regard to an electronic signature. Thus, the Board erred in relying on a 2004 dictionary (i.e., finding of fact 3) to define a term in an application filed in 2000.

2). The Board erred by unnecessarily imputing a new definition to Appellants' term "electronic signature." A claim term takes its ordinary meaning in the art unless the Appellants redefined the term using words of "manifest exclusion or restriction." *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir. 2002). The Board's need to try to define a claim term in a manner that differs from its ordinary and accepted meaning in the art is itself clear evidence of record that the claims are not legally anticipated.

3). The Board did not need to impute a new definition to Appellants' term "electronic signature" because in 2000 the ordinary meaning of the term was already defined by Federal statute. The U.S. Code at title 15, chapter 96, subchapter I § 7006 (5) states that electronic signature "means an electronic sound, symbol, or process, attached to or logically associated with a contract or other record and executed or adopted by a person with the intent to sign the record." Thus, electronic signature cannot be a person's legally binding signature unless there was *intent* by the person to have the electronic signature be the person's legal signature.

This same definition was pointed out to the Office in Appellants' Reply Brief. The USPTO also understands what constitutes an "electronic signature", especially a particular type thereof (MPEP § 502.02 (III)).

Appellants' disclosure provides numerous examples of *intent* (e.g., consent, agreement) by a person to have their image be their electronic signature. That is, Appellants' disclosure of what constitutes an electronic signature corresponds to the ordinary meaning recognized in the statute. Since the Board relied upon a different definition of "electronic signature", instead of the ordinary (and disclosed) meaning, the Decision is in error.

The Decision indicates that the Board is unfamiliar with the well known term "electronic signature." If true, then the Board could not have considered the issues from the perspective of ordinary skill in the art.

4). The Board erred by imputing a new (incorrect) definition while not establishing that one of ordinary skill in the art, in light of Appellants' disclosure, would disagree with the ordinary meaning of the term "electronic signature." One skilled in the art in November 2000 would have understood that in light of Appellants' disclosure, "electronic signature" (in accordance with the Federal statute) comprises an electronic symbol (e.g., an image) associated with a record (e.g., document such as a check), where the electronic symbol (e.g., an image) is adopted (legally taken) by a person (e.g., machine user) with the intent to sign (as the signature of) the record (e.g., document). That is, one skilled in the art at the time of Appellants' invention in light of Appellants' disclosure would have recognized Appellants' recited "electronic signature" to include an electronic image (of an automated banking machine user) which is intended by the user to constitute the user's legal signature of an associated document.

5). The Board did *not* give “electronic signature” “the broadest *reasonable* construction consistent with *the Specification*” (Decision at page 7, last paragraph). Again, Appellants’ disclosure provides ample support for a person agreeing (intending) to have their image be their electronic signature, which support is fully aligned with the ordinary meaning of the term recognized in the statute.

Also, the Decision erred by not taking into consideration the legal precedent that “giving claims their broadest *reasonable* interpretation during examination does *not* include giving claims a legally *incorrect* interpretation” (*Skvorecz*, at 8). As discussed in more detail later, the Board’s interpretation of “electronic signature” as constituting any user image or the mere taking of a user image, is neither reasonable nor legally correct. Thus, the Decision is further erroneous.

Error #2

In view of Error #1, the Board further erred by agreeing that in Stinson “the taking of the image reads on an ‘electronic signature’” (Decision at page 7, last paragraph). The Board alleges, in view of its construed definition, that Stinson’s taking of a user image is “a process associated with a check that is the legal equivalent of a written signature” (Decision at page 7, last paragraph). However, the Board’s allegation lacks support via concrete evidence of record. Nowhere has the Board factually established in the record that Stinson teaches that a user “image” or “the taking of the image” “is the legal equivalent of a written signature.” Any fair reading of Stinson shows that Stinson only makes use of a user’s image to confirm the identity of a person trying to cash a check, and not as that person’s legal signature. Thus, even when using the Board’s definition of “electronic signature”, Stinson still fails to teach electronic signature.

When using the Federal statute's definition of "electronic signature", Stinson is even further removed from teaching electronic signature. As previously discussed, an electronic signature cannot be a person's legally binding signature unless there was *intent* by that person to have the electronic signature be that person's legal signature. Nowhere does Stinson teach that a person intends to have their image be their legally binding signature. One of ordinary skill in the art would understand that Stinson does not teach any need (let alone any intent) for an electronic signature, especially when Stinson already requires a user's written signature. Thus, the Decision is faulty.

At best, Stinson uses a user image to confirm the identity of a customer, not to legally sign a document. One of ordinary skill in the art would recognize that the taking of a user's image in Stinson is as far from an "electronic signature" as was the taking of a Board member's picture for their USPTO ID badge. In neither situation was there any *intent* by the person (i.e., Stinson user or Board member) to have their image/picture be used to legally sign a document.

Error #3

The Board defined "apply" (for applying) to solely mean "to lay or spread on" (i.e., finding of fact 7). However, Appellants' disclosed use of "applying" corresponds with its ordinary meaning. Thus, the Board did *not* give "applying" "the broadest *reasonable* construction consistent with *the specification*" (Decision at page 9) and its ordinary meaning. The Board is not permitted to arbitrarily pick and choose any definition. Yet it did.

The dictionary (Merriam-Webster's Collegiate Dictionary, 1993) relied upon by the Board is limited in the number of definitions it provides, because of its intended audience. The Board has not established that a "collegiate" audience is the audience of one of ordinary skill in

the art. Nor has the Board established that one of ordinary skill in the art would rely solely on a "collegiate" dictionary, and further rely only on one definition from that dictionary. Thus, the Decision is in error because the source it relied upon was too narrow.

One of ordinary skill in the art would know that an unabridged dictionary would provide a more comprehensive listing of definitions for a single word than would a collegiate dictionary. For example, in Webster's unabridged dictionary of 1996 the term "apply" has at least ten definitions (which can also be found at <http://dictionary.reference.com/browse/applying>). Definition #5 is "to use for or assign to a specific purpose" (e.g., assign indicia to a specific document). Definition #3 is "to place in contact with; lay or spread on" (e.g., spread butter on toast). It is a fact that none of the terms "lay", "laying", "spread", or "spreading" (Decision at page 9) is found in Appellants' disclosure.

It is a fact that dictionaries list definitions in the order of their most common meanings. One of ordinary skill in the art would understand that definition #5 is in accordance with Appellants' disclosure. That is, an available pertinent definition (definition #5) is listed long before the Board's chosen definition (definition #8). Appellants request the Board to explain (for later review by the Federal Circuit) how the Board's deliberate limiting choice of a definition (related to spreading butter on toast), which has significantly less in common with Appellants' disclosure than other more pertinent and available definitions (e.g., definition #5), is not arbitrary and capricious action against Appellants.

Also, the Board further errs in improperly attempting to limit "indicia" (e.g., claim 2) to being "on" a document. Any limiting of "indicia" that excludes "electronic indicia" is legally improper in view of Appellants' disclosure. The Board provides no legal basis for such injurious

limitation. Nor does the Board explain how an electronic document (e.g., claims 10 and 23) could have indicia applied thereon by “laying” or “spreading.”

The Board erred by not establishing in the record that one of ordinary skill in the art, in view of Appellants’ disclosure, would agree with the Board’s definition applied to “applying.” As the Decision is based on these many noted errors, the Decision is legally improper.

IV. Other Points Misapprehended or Overlooked by the Board

Point #1

The Board’s statement that the “check cashing machine will not cash a check without a user image” (Decision at page 8, lines 1-2) implies that every check cashing approval in Stinson requires that there be a match between a user’s captured image and a stored image of the user. This is not true. In Stinson, a human operator can always cash a check in response to calling the check maker (e.g., Figures 11Q, 12B, 13A-B, 13E-H, 13K-M, and 13R). Stinson teaches that even a new customer (who would not have any stored image usable for image matching) can have a check cashing transaction approved (e.g., col. 4, lines 23-30; Figure 13B). Thus, Stinson’s check cashing machine *can* cash a check without any dependency (or requirement) whatsoever on a user image.

Since Stinson does not require a user image for check cashing, it follows that Stinson does not require an electronic signature for check cashing. The Decision is further faulty because it is incorrectly based on a demonstrably incorrect holding that Stinson requires a user image in order to have a check approved for cashing.

The Board misinterprets what Stinson *does* require. As noted in the Appeal Brief, even the Examiner admits that Stinson requires that the user endorse (sign) a check by writing their

signature on the check. The facts of record show that Stinson's requirement for a *handwritten* signature teaches away from Stinson using (or ever needing) an *electronic* signature.

Point #2

The Board further erred by holding that in Stinson "allowing the check cashing machine to take an image reads on the claimed step [claim 1(b)] of receiving an input from the user of the machine indicative of the user's agreement . . . to have their image taken" (Decision at page 8, lines 4-10). However, the alleged claim language is not the actual claim 1, step (b) language. As can be seen, the claim 1, step (b) language is *not* directed to a user's agreement to have their image taken, as alleged and relied upon by the Board. Rather, the claim 1, step (b) language actually states what the user agrees to have in their *electronic signature*. Specifically the user agrees that "the user's electronic signature shall include . . . image of . . . the user." The Decision is erroneous because it finds anticipation based on different and much broader language than what is actually recited in the claim.

Point #3

The Board erred by not considering all claim language in each claim. Anticipation is a question of *fact*, and is reviewed accordingly. *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). As previously noted, the Board did *not* review the facts on which the allegation of anticipation was based. Rather, the Board (improperly) only reviewed whether Appellants showed that the Examiner was in error.

Anticipation requires that the *identical* invention to what is claimed be described in the reference. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). How can there be an "*identical* invention" when Stinson does not even mention "electronic signature?"

As the Decision is not based on all claim language (which further shows that the identical claimed invention is not described in Stinson) and thus the Decision is not based on all the facts of record, it is erroneous. Some claim language/facts not considered by the Board will now be discussed:

Claim 17

The Board repeats in its Decision the language of claim 17, step (b). However, the Board never addresses the claim language with regard to anticipation. At best the Board assumes that claim 17 is "Like claim 1" (Decision at page 13). This assumption is incorrect. One of ordinary skill in the art would recognize that claim 17 recites *additional* features and relationships than claim 1. The Appellants are still waiting for the Board to address (on the record) these additional features and relationships with regard to the Examiner's allegation of anticipation, in accordance with 35 USC § 6(b).

The Board's statement that "Appellant traverses the rejection of claim 17 for the *same* reasons as argued in regards to the rejection of claim 1" is in error. The Appellants (at Appeal Brief page 23) specifically argued that Stinson did not teach the additionally recited features and relationships. For example, Appellants argued that

"Stinson does not teach receiving from a user of an automated banking machine, input that indicates that the user agrees for his/her electronic signature (for purposes of providing legal effect to the document) to include data corresponding to his/her input to the machine. Where does Stinson teach that a *user of the machine* provides agreement input regarding the legal composition of electronic signature data? Stinson teaches neither an electronic signature/user input relationship nor a user agreement for that relationship."

One of ordinary skill in the art would understand that in Stinson, a user's image (or the taking of the user's image) would *not* provide any legal effect with regard to a check. The check would have the same legal status whether the user's image was or wasn't taken. In Stinson, the user's image is only used to verify the user, not to provide legal effect with regard to the user's check. This is a fact which has been overlooked by the Board.

Additionally, as previously discussed, a user's check in Stinson can be cashed *without* any user image (e.g., a new user; a call to the check maker; etc.). How then can a user image be needed to provide legal effect to a check? It cannot.

The record shows that the Board has not addressed *all* of the features of claim 17, nor *all* of Appellants' arguments with regard to the recited features of claim 17. As a result, the Decision is incomplete and defective. An Appellant should not have to file a Rehearing Request to request that the Board address all of the appealed issues.

Claim 18

Certain comments in the Decision are further evidence that neither all of the recited language nor all of Appellants' arguments were fully considered. For example, the Board's comment against claim 18 patentability is based on language (e.g., "endorsement of the negotiable instrument") which is *not* even in claim 18.

Claim 21

The Board acknowledges Appellants' argument that "Stinson does not describe acquiring user image data through operation of the machine, and storing in correlated relation both data corresponding to the user agreement input and the user image data." That is, Appellants argued that Stinson does not teach storing both (1) user agreement input data and (2) acquired user

image data in correlated relation. The Board indicated that “For the same reasons as discusses [sic] with regards [sic] to claims 1 and 11, we find that Stinson describes this limitation.” The Board errs because claim 21/17 is not equivalent to claim 11/1.

Furthermore, with regard to claim 11 the Board equated storing “the customer’s social security number, the check amount entered by the customer and the image of the customer” with “storing user input data in correlated relation with user image data.” The Board errs by overlooking the additional “agreement” feature of claim 21 (and claim 11), i.e., storing user *agreement* input data. None of the social security number, the check amount, or the customer image is stored (in correlated relation with the customer image) as user agreement input data. Nor does the Board allege such storage arrangement. Rather, the Board (at Decision page 8) indicates that a user (in Stinson) pressing the OK button constitutes the user’s agreement input.

The Board overlooks the fact that Stinson does not *store* “OK button was pressed” data, especially in correlated relation with the user’s image. At best understood, the Board is improperly attempting to read the user’s image on both (1) “OK button was pressed” data and (2) the customer’s image. It follows that Stinson does not teach *storing* in correlated relation *both* (1) user agreement input data *and* (2) acquired user image data. As the Board did not consider all of the claim language, the Decision is faulty.

Claim 22

The Board’s remarks (at Decision pages 15-16) concerning *claim 21* are unclear.

Claim 26

The Board acknowledges Appellants’ argument that Stinson does not teach controller software that “is operative to cause the output device to ask the user for agreement that image

data shall constitute an electronic signature of the user for purposes of signing the document.” In reply to Appellants’ argument the Board states “we find that the [sic] Stinson depicts in Fig. 16 asking the user to press an “OK” button before the image is taken. FF 15. We find that this depiction reads on this limitation for the same reasons as discusses [sic] with regards [sic] to the receiving step in claim 1.” The Board errs by adding matter to Stinson what Stinson does not teach, and then relying on this new matter in making their decision regarding the patentability of claim 26.

Stinson’s lower right depiction in Figure 16C shows the relied upon OK button and text. The text states “if you are wearing a hat or sunglasses please remove them now and press:.” One skilled in the art of the English language would understand that Stinson’s text message is not an asking (i.e., to put a question to), but rather an order/command. Also, note the dictionaries relied upon by the Board with regard to “ask”, “order”, and “command.” Thus, on sentence structure alone Stinson’s text message is not asking anything, especially “asking the user to press an ‘OK’ button”, as relied on by the Board.

Even if it were somehow possible (which it isn’t) for Stinson’s text message to be an “asking” as alleged by the Board, the Board does not explain (nor can it) how the message equates to asking “the user for agreement that image data shall constitute an electronic signature of the user for purposes of signing the document.” One skilled in the art of self-service machines which take user pictures (like Stinson’s machine) would understand that Stinson’s OK button exists solely to notify the machine that the user is now ready (e.g., sunglasses have been removed) to have their picture taken. The OK button does *not* relate in any manner to asking a user if they agree that the user’s image shall constitute the user’s electronic signature, especially

for the purpose of signing a document. Nor does a user pressing the OK button relate in any manner to a user agreement input that the user's image shall constitute the user's electronic signature, especially for the purpose of signing a document.

The Board incorrectly interpreted the teaching of Stinson. Thus, the Decision (which is based on this incorrect interpretation) is in error.

Claim 30

The Board again incorrectly interpreted the teaching of Stinson. Stinson does not store in correlated relation, data for each of (1) a user's image, (2) a document's image, and (3) a user's agreement (input agreeing that the user's image shall constitute the user's electronic signature for signing a document), as alleged and relied upon by the Board with regard to the patentability of claim 30/29/26. Thus, the Decision is in error.

Claim 36

The Board states that "Appellant traverses the rejection of claim 36 for the *same* reasons as argued in regards to the rejection of claim 1" and "because we found the Appellant's arguments unpersuasive with respect to claim 1, we find them *equally* unpersuasive with respect to claim 36." However, claim 36 is not *equal* to claim 1. For example, claim 36 has four steps, whereas claim 1 has only three steps. Nor are Appellants' claim 36 arguments the *same* as Appellants' claim 1 arguments. The record shows that the Board admits that it did not consider *all* of the language of claim 36, nor *all* of Appellants' claim 36 arguments. Thus, the Decision is admittedly defective.

At best, the Board only considered steps (b) and (c). For reasons previously discussed herein, the Board errs because Stinson does not teach step (b). Nowhere does Stinson teach a

user agreeing that the user's image will constitute a legally binding electronic signature of the user for processing a check, let alone the machine receiving such user agreement.

The Board did not consider claim 36 as a whole, but rather takes the steps individually and out of context. For example, the Board did not consider step (d). It follows the Board did not give proper weight to the recited "as the" and "for" features explicitly recited in step (d). Nor did the Board consider step (d) in conjunction with steps (a)-(c). The record is absent evidence that Stinson correlates a user's electronic signature (in the form of the user's image) with a check to enable processing of that check with a signature. As the Decision is based on non existent evidence, it is in error.

Claim 36 is a method claim which was rejected under anticipation. At best, the Decision smacks of attempted "obviousness." Thus, the Decision is further in error.

Claim 37

The Board states that "Appellant traverses the rejection of claim 37 for the *same* reasons as argued in regards to the rejection of claim 26" and "because we found the Appellant's arguments unpersuasive with respect to claim 26, we find them *equally* unpersuasive with respect to claim 37." However, claim 37 is not *equal* to claim 26. Nor are Appellants' claim 37 arguments the *same* as Appellants' claim 26 arguments. The record shows that the Board admits that it did not consider *all* of the language of claim 37, nor *all* of Appellants' claim 37 arguments. Thus, the Decision is admittedly defective.

The Board did not consider each of the claim 37 steps, nor the claim as a whole. The Decision is in error because it relies on features not taught by Stinson (i.e., it is not based on evidence of record). For example, the Decision incorrectly relies on Stinson as teaching an

output that requests the user to authorize the machine to use their user identity data to serve as their electronic signature. The Decision also incorrectly relies on Stinson as teaching the machine receiving inputted user authorization to have their user identity data serve as their electronic signature. The Decision also incorrectly relies on Stinson as teaching that the machine links the user identity data to a document (to which a signature of the user has legal significance) in a manner such that the user identity data serves as the user's (electronic) signature for that document. Stinson teaches none of these.

Point #4

The Board errs by imputing subject matter to Stinson that Stinson does not explicitly or inherently teach. "To establish inherency, the extrinsic evidence must make *clear* that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill . . . Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The record shows that what the Board relies on in Stinson is actually wishful reasoning, rather than the legally required concrete factual evidence of record. As a result, the Decision is erroneous.

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Conclusion

The Appellants have shown that there are several points that have been misapprehended or overlooked by the Board in its Decision. The Appellants have also shown that the legal standard for review was not followed by the Board. As a result, it is respectfully submitted that the Decision is erroneously based and should be withdrawn, and the rejections of all independent claims should be reversed.

Respectfully submitted,



Ralph E. Jocke
Daniel D. Wasil
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256

Reg. No. 31,029
Reg. No. 45,303

Customer No. 28995
(330) 721-0000